Attorney's Docket: 2003CH109
Serial No.: 10/552,603
Group: 1796

REMARKS

The Office Action mailed October 25, 2007, has been carefully considered together with each of the references cited therein. The remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

CLAIM STATUS

Claims 1-15 stand rejected under 35 USC § 103(a) as being unpatentable over Hess et al. (US 4,780,494) in view of Beilfuss et al. (5,756,500) and Takei et al. (US 6,444,320). This rejection is respectfully traversed.

As claimed, Applicant's invention is directed to a storage stable aqueous dispersion comprising a light stabilizer or a mixture of a light stabilizer and an antioxidant, a polyglycol as a solubilizer and 0.2% to 5% by weight of oleic acid as a flow improver . . . As stated on Page 3, Paragraph 25 of Applicant's specification:

> The object of the present invention was to improve the storage stability of highly concentrated aqueous dispersions of a light stabilizer or of a mixture of a light stabilizer and an antioxidant. (underlining added)

The Office begins its position by stating that Hess et al. "disclose an aqueous dispersion comprising one or more 2, 2, 6, 6-tetraalkylpiperidines having a melting point of 100°C or more; one or more cationic, non-ionic and/or anionic dispersing agents that read on the wetting agent; and an aqueous medium (abstract)." On the top of Page 4 of the Office Action, the Office admits that "Hess et al. is silent with respect to polyglycol as a solubilizer, biocide and its weight percent; oleic acid as flow improver" as well as the viscosity of the aqueous dispersion, its storage stability and the method of improving storage stability. The Office attempts to rectify the deficiencies of Hess et al. by invoking Beilfuss et al. as a source for the use of polyglycol as a solubilizer and Takei et al. as a source for the oleic acid.

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It is Applicant's respectful position that the Office has not established a *prima facie* case of obviousness with respect to Applicant's invention. A close examination of the secondary references reveals that Beilfuss et al. is directed to an aqueous dispersion having a fungicidal and algicidal effect. This is made clear by reference to Column 1, lines 35-40 of such reference wherein it is stated:

> It is therefore the object of the invention to make available an aqueous dispersion with fungicidal and algistatic effectiveness, including effectiveness against Alternaria species, which satisfactorily eliminates the disadvantages mentioned above.

Within Beilfuss et al. there is absolutely no disclosure, teaching or suggestion of a light stabilizer composition or of a mixture of a light stabilizer and an antioxidant in an aqueous dispersion having enhanced storage stability. Furthermore, Takei et al. unequivocally shows that such reference is directed to polymers for anti-reflective or fill compositions. As disclosed in Column 1, line 65 through Column 2, Line 4:

> The present invention is broadly concerned with new polymers for use in preparing anti-reflective or fill compositions and methods of using those compositions to protect substrates, and particularly contact and via holes formed therein, during circuit manufacturing.

Takei et al., as with Beilfuss et al., is not concerned with, and provides no guidance to one with ordinary skill in the art seeking an aqueous dispersion of a light stabilizer or of a mixture of a light stabilizer and an antioxidant that has increased storage stability.

In the Office's attempt to justify its § 103 rejection, it argues on Page 4 that the Beilfuss et al. reference discloses polyglycol and concludes:

> Therefore, it would have been obvious to use polyglycol as a solubilizer and add fungicide to the aqueous

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dispersion of Hess et al., for the above mentioned advantages.

Similarly, to overcome the deficiencies in Hess et al. the Office opines that oleic acid is taught by Takei et al. as a flow improver and concludes, citing *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 US 327, 65 USPQ 297 (1945), that selection of a known material based on its suitability for its intended use supports *prima facie* obviousness.

To begin, one with ordinary skill in the art having a knowledge of Hess et al. would look to neither Beilfuss et al. or Takei et al. for guidance as to how to increase the storage stability of an aqueous dispersion containing a light stabilizer or a mixture of a light stabilizer and an antioxidant. The reason such ordinary artisan would not look to the above mentioned references for guidance is because Takei et al. and Beilfuss et al. are not at all concerned with light stabilizer compositions. In contrast, such references are directed to chemically disparate compositions. One of ordinary skill would not at all entertain the teachings of Beilfuss et al. or Takei et al. as being salient to the problem of creating a storage stable aqueous dispersion containing a light stabilizer, or of a mixture of a light stabilizer and an antioxidant, for the simple reason that neither reference is directed to light stabilizer compositions. As one with ordinary skill knows, a composition's storage stability is a function of its constituents. In consequence, one of ordinary skill, having a knowledge of Hess et al. and a desire to increase the storage stability of its aqueous dispersion, could find no motivation for deploying the teachings of Takei et al. or Beilfuss et al. and arrive at the instantly claimed invention. Such motivation is lacking because of the fact that the stability of a composition depends upon its chemical makeup. Given this fact, when addressing the issue of storage stability of light stabilizer aqueous compositions, an ordinary artisan would find an inapposite the guidance of Takei et al. and Belfuss et al. With that fact in mind, one with ordinary skill in the art would not entertain the teachings of either Beilfuss et al. or Takei et al. as the artisan would not believe that such teachings could be excised from such references and used to

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create a light stabilizer aqueous composition with enhanced storage stability with any reasonable expectation of success.

As § 2141 of the MPEP makes clear, in reference to *KSR*, "the key to supporting any rejection under 35 USC § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." In §§ 2141 and 2143 the MPEP provides a list of exemplary rationales that can support a conclusion of obviousness. Such rationales include the following:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" – choosing from a finite number of identified,predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

With respect to all of these rationales, none of them are applicable to the instant case. With respect to rationales A, B, D and F, courteously stated, the Office can not put forward the conclusion that the combination as proffered by the Office would result in predictable results. As explained above, storage stability of a

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composition is highly dependent upon it constituents and consequently, one with ordinary skill in the art could not look to Beilfuss et al. and Takei et al., both of which do not speak to light stabilizer compositions and expect any predictable results from the modification of Hess et al. as argued by the Office. . Concerning rationale C, use of a known technique to improve a similar device (method or product) in a similar way; such rational is not applicable here as Takei et al. and Beilfuss et al. are directed to chemical compositions that are entirely dissimilar to aqueous dispersions of light stabilizers. Concerning rationale E, this rationale requires a reasonable expectation of success. It is Applicant's respectful contention that there is no reasonable expectation of success which could be gained by the ordinary artisan if it engaged in the combination as proffered by the Office. As previously stated, the storage stability of a composition is highly dependent upon its constituents. As Takei et al. and Beilfuss et al. do not speak to light stabilizer aqueous dispersions, one with ordinary skill in the art could enjoy no reasonable expectation of success that modifying Hess in the manner described by the Office would yield an aqueous dispersion of light stabilizer composition with enhanced storage stability.

Concerning rationale G, the traditional TSM test, Applicant has above described in detail why such motivation is lacking for one with ordinary skill in the art to entertain the combination proffered by the Office.

Given the above, Applicant's courteously suggest that the Office has engaged in the use of impermissible hindsight based upon a knowledge of Applicant's specification and selectively picked various elements from non-analogous references to arrive at a conclusion of obviousness. It is well settled that using an Applicant's specification as a blue print to construct the claimed invention from lifting various pieces of the prior art contravenes the statutory mandate of § 103. See e.g. *Grain Processing Corp. v. American Maize Products Co.* 5 USPQ 2d 1788, 1792 (Fed. Cir. 1988). Thus, it is respectfully contended that the Office has not fulfilled its mandate as required by the rationales of *KSR* and has, instead, courteously stated, reconstructed Applicant's invention by means of impermissible hindsight.

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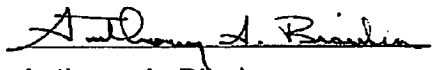
In view of the foregoing, it is respectfully contended that the 35 USC § 103 rejection has been traversed. In consequence, Applicant respectfully requests reconsideration and withdrawal of the rejection.

In view of the forgoing remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Office disagrees, the Examiner is invited to contact the attorney for Applicant at the telephone number provided below.

Respectfully submitted,



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